

100



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,213	11/19/2001	Marc Alizon	3495.0050-16	8195

22852 7590 04/07/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

PARKIN, JEFFREY S

ART UNIT PAPER NUMBER

1648

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/988,213		ALIZON ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Jeffrey S. Parkin, Ph.D.		1648	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Serial No.: 09/988,213  
Applicants: Alizon, M., et al.

Docket No.: 3495.0050-16  
Filing Date: 11/19/01

## Detailed Office Action

### *Status of the Claims*

Acknowledgement is hereby made of receipt and entry of the response submitted 29 December, 2003. No claim amendments accompanied the response. Claims 44-46 are currently under examination.

### *Drawings*

The proposed drawing corrections and/or substitute sheets of drawings (Figure 6) filed on 29 December, 2003, have been approved. Applicants are reminded that the disclosure must be amended to include a brief description of the figures (including panel descriptions).

### *Disclosure*

The disclosure is objected to because of the following informalities: the disclosure fails to provide a figure description for newly submitted figure 6. Appropriate correction is required.

### *35 U.S.C. § 112, Second Paragraph*

The previous rejection of claims 44-46 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby withdrawn in response to applicants' amendment.

### *35 U.S.C. § 112, First Paragraph*

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person

skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44-46 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *In re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976). To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc., v. Mahurkar*, 935 F.2d at 1563, 19 U.S.P.Q.2d at 1116. As previously set forth, the crux of the rejection is directed toward whether or not the original application provides adequate written support for the terms **"at least a portion of a pol gene"**, **"at least a portion of the nucleic acid sequence of a pol gene"**, or **"at least one domain in a pol gene of HIV-1<sub>BRU</sub>"**. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997). The claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function.

A biomolecule sequence described only by functional

characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the biomolecule of interest. *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993). *In re Deuel*, 51 F.3d 1552, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995). A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d 1895, 1905 (Fed. Cir. 1995). The court noted in this decision that a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not reasonably lead those skilled in the art to any particular species.

An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. For some biomolecules, examples of identifying characteristics include a nucleotide or amino acid sequence, chemical structure, binding affinity, binding specificity, and molecular weight. The written description requirement may be satisfied through disclosure of function and minimal structure when there is a well-established correlation between structure and function. Without such a correlation, the

capability to recognize or understand the structure from the mere recitation of function and minimal structure is highly unlikely. In the latter case, disclosure of function alone is little more than a wish for possession; it does not satisfy the written description requirement. *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 U.S.P.Q.2d 1398, 1404, 1406 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998). *In re Wilder*, 736 F.2d 1516, 1521, 222 U.S.P.Q. 369, 372-3 (Fed. Cir. 1984). Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention.

Perusal of the disclosure revealed the cloning and characterization of a novel human immunodeficiency virus type 2 (HIV-2). The nucleotide sequence, and deduced amino acid sequence, of a full-length *pol* gene were determined from a proviral molecular clone (see Examples 4 and 5, respectively). A single Gag peptidic fragment was disclosed in Example 6 corresponding to nt 991-1053. This was the only gag fragment disclosed in the application. This particular region was chosen because of its genetic relatedness to HIV-1. However, the disclosure fails to identify any other fragments or portions of the *pol* gene or polypeptide. The disclosure fails to identify other regions within this structural gene that may be useful as diagnostic reagents or for the generation of polypeptide fragments and immunological reagents. The disclosure also fails to identify suitable nucleotide sequences that hybridize to the *pol* gene under the claimed hybridization parameters. Thus, the skilled artisan would reasonably conclude that applicants were in possession of the full-length *pol* gene and

a single fragment corresponding to nt. 991-1053. However, the skilled artisan would also reasonably conclude that applicants were **not** in possession of the large genus corresponding to Pol polypeptide fragments, nucleic acid sequences encoding said fragments, and nucleic acid probes that are capable of hybridizing to said fragments under the recited conditions. Thus, it appears that applicants are attempting to capture subject matter to which they are clearly not entitled.

Applicants traverse and submit that the Examiner is applying improper legal criteria in making the rejection. Applicants argue that the case law does not require that the inventors actually reduce the claimed invention to practice. It only requires that the inventors describe the limitation as part of the invention. Applicants argue that although various specific fragments of *gag* and *env* have been enumerated, it does not exclude similar fragments in *pol*. Applicants also point to Figures 3 and 5 in support of their position. Finally, applicants note that it is not necessary that specific sequence information be provided for each and every fragment encompassed.

Applicants' arguments have been carefully considered but are not deemed to be persuasive for the reasons of record set forth *supra*. The first paragraph of 35 U.S.C. § 112 requires that the "specification shall contain a written description of the invention ...." This requirement is separate and distinct from the enablement requirement. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 U.S.P.Q.2d 1111, 1114 (Fed. Cir. 1991). The written description requirement has several policy objectives. "[T]he essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4, 194 U.S.P.Q. 470, 473 n.4 (C.C.P.A. 1977). Another objective is to put the public in possession of what the applicant

claims as the invention. See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 U.S.P.Q.2d 1398, 1404 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). The written description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 U.S.P.Q.2d at 1116. However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 1330, 63 U.S.P.Q.2d 1609, 1617 (Fed. Cir. 2002). Much of the written description case law addresses whether the specification as originally filed supports claims not originally in the application. The issue raised in the cases is most often phrased as whether the original application provides "adequate support" for the claims at issue or whether the material added to the specification incorporates "new matter" in violation of 35 U.S.C. § 132. The "written description" question similarly arises in the interference context, where the issue is whether the specification of one party to the interference can support the newly added claims corresponding to the count at issue, i.e., whether that party can "make the claim" corresponding to the interference count. See, e.g., *Martin v. Mayer*, 823 F.2d 500, 503, 3 USPQ2d 1333, 1335 (Fed. Cir. 1987). In addition, early opinions suggest the Patent and Trademark Office was unwilling to find written descriptive support when the only description was found in the claims; however, this viewpoint was rejected. See *In re*



*Koller*, 613 F.2d 819, 204 U.S.P.Q. 702 (C.C.P.A. 1980) (original claims constitute their own description); accord *In re Gardner*, 475 F.2d 1389, 177 U.S.P.Q. 396 (CCPA 1973); accord *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (CCPA 1976). It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. These early opinions did not address the quality or specificity of particularity that was required in the description, i.e., how much description is enough.

Prior to determining whether the disclosure satisfies the written description requirement for the claimed subject matter, the examiner should review the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention. An element may be critical where those of skill in the art would require it to determine that applicant was in possession of the invention. Compare *Rasmussen*, 650 F.2d at 1215, 211 U.S.P.Q. at 327 ("one skilled in the art who read *Rasmussen's* specification would understand that it is unimportant how the layers are adhered, so long as they are adhered") (emphasis in original), with *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1206, 18 U.S.P.Q.2d 1016, 1021 (Fed. Cir. 1991) ("it is well established in our law that conception of a chemical compound requires that the inventor be able to define it so as to distinguish it from other materials, and to describe how to obtain it"). The analysis of whether the specification complies with the written description requirement calls for the examiner to compare the scope of the claim with the scope of the description to determine whether applicant has demonstrated possession of the claimed invention. Such a review is conducted from the standpoint of one of skill in the art at the time the application was filed (see, e.g., *Wang Labs. v. Toshiba*

Corp., 993 F.2d 858, 865, 26 U.S.P.Q.2d 1767, 1774 (Fed. Cir. 1993)) and should include a determination of the field of the invention and the level of skill and knowledge in the art. Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. Information which is well known in the art need not be described in detail in the specification. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

Possession may be shown in many ways. For example, possession may be shown by describing an actual reduction to practice of the claimed invention. Possession may also be shown by a clear depiction of the invention in detailed drawings or in structural chemical formulas which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention. An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. See, e.g., *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 U.S.P.Q.2d 1481, 1483 (Fed. Cir. 2000) (the written description "inquiry is a factual one and must be assessed on a case-by-case basis"); see also *Pfaff v. Wells Electronics, Inc.*, 55 U.S. at 66, 119 S.Ct. at 311, 48 U.S.P.Q.2d at 1646 ("The word invention must refer to a concept that is complete, rather than merely one that is substantially complete."). It is true that reduction to practice ordinarily provides the best evidence that an invention is complete. But just because reduction to practice is sufficient evidence of completion, it does not follow that proof of reduction to practice is necessary in every case. Indeed, both the facts of the Telephone Cases and the facts of this case demonstrate

that one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice.").

An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, 935 F.2d at 1565, 19 U.S.P.Q.2d at 1118 ("drawings alone may provide a written description of an invention as required by Sec. 112"); *In re Wolfensperger*, 302 F.2d 950, 133 U.S.P.Q. 537 (C.C.P.A. 1962) (the drawings of applicant's specification provided sufficient written descriptive support for the claim limitation at issue); *Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 U.S.P.Q. 697, 703 (Ct. Cl. 1967) ("In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification."); *Eli Lilly*, 119 F.3d at 1568, 43 U.S.P.Q.2d at 1406 ("In claims involving chemical materials, generic formulae usually indicate with specificity what the generic claims encompass. One skilled in the art can distinguish such a formula from others and can identify many of the species that the claims encompass. Accordingly, such a formula is normally an adequate description of the claimed genus."). The description need only describe in detail that which is new or not conventional. See *Hybritech v. Monoclonal Antibodies*, 802 F.2d at 1384, 231 U.S.P.Q. at 94; *Fonar Corp. v. General Electric Co.*, 107 F.3d at 1549, 41 U.S.P.Q.2d at 1805 (source code description not required). This is equally true whether the claimed invention is directed to a product or a process.

An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial

structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. For example, the presence of a restriction enzyme map of a gene may be relevant to a statement that the gene has been isolated. One skilled in the art may be able to determine whether the gene disclosed is the same as or different from a gene isolated by another by comparing the restriction enzyme maps. In contrast, evidence that the gene could be digested with a nuclease would not normally represent a relevant characteristic since any gene would be digested with a nuclease. Similarly, isolation of an mRNA and its expression to produce the protein of interest is strong evidence of possession of an mRNA for the protein.

For some biomolecules, examples of identifying characteristics include a sequence, structure, binding affinity, binding specificity, molecular weight, and length. Although structural formulas provide a convenient method of demonstrating possession of specific molecules, other identifying characteristics or combinations of characteristics may demonstrate the requisite possession. For example, unique cleavage by particular enzymes, isoelectric points of fragments, detailed restriction enzyme maps, a comparison of enzymatic activities, or antibody cross-reactivity may be sufficient to show possession of the claimed invention to one of skill in the art. See *Lockwood*, 107 F.3d at 1572, 41 U.S.P.Q.2d at 1966 ("written description" requirement may be satisfied by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention"). A definition by function alone "does not suffice" to sufficiently describe a coding sequence "because it is only an indication of what the gene does, rather than what it is." *Eli Lilly*, 119 F.3d at 1568, 43 U.S.P.Q.2d at 1406. See also *Fiers*, 984 F.2d at 1169-71, 25 U.S.P.Q.2d at 1605-06 (discussing *Amgen Inc. v.*

*Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991)).

Applicants' reliance on Figures 3 and 5 is not convincing. Neither of these figures identify any specific *pol* fragments or domains. Figure 3 simply illustrates the HIV-2 is genotypically distinct from HIV-1. It does not disclose any particular *pol* fragments or domains from Figure 6. Figure 5 is simply a preliminary restriction map of three overlapping HIV-2<sub>ROD</sub> clones that were used to isolate and characterize the full-length provirus. However, nothing in this figure directs the skilled artisan toward any particular *pol* fragment or domain. The disclosure does describe 11 specific *env* fragments and one specific *gag* fragment (e.g., see pages 41-42). However, these fragments are believed to correspond to hydrophilic regions that may prove useful as antigens. No such regions are identified or discussed in the corresponding *pol* gene. Thus, there is no indication from reading the disclosure that applicants contemplated making and using the claimed invention. Accordingly, the rejection is proper and hereby maintained.

#### ***Finality of Office Action***

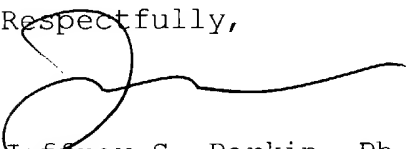
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). **A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY**

ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE  
LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

*Correspondence*

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 9:30 AM to 7:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, Laurie Scheiner or James Housel, can be reached at (571) 272-0910 or (571) 272-0902, respectively.

Respectfully,



Jeffrey S. Parkin, Ph.D.  
Patent Examiner  
Art Unit 1648

02 April, 2004



MARK NAVARRO  
PRIMARY EXAMINER